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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,939	10/30/2003	Akihiro Miyauchi	520.43241X00	6291
20457 7590 09/15/2009 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873				
EXAMINER HYUN, PAUL SANG HWA				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 09/15/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/695,939

Applicant(s)

MIYAUCHI ET AL.

Examiner

PAUL S. HYUN

Art Unit

1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 03 September 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 11-13 and 28-32.
Claim(s) withdrawn from consideration: 9, 16, 27, 33 and 34.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Continuation of 3. NOTE: Proposed amendment to claims 33 and 34 further limits said claims by reciting the aspect ratios of the micro pillars formed by the claimed methods. The proposed amendment further limits the scope of said claims, raising new issues that would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive. Applicant's arguments with respect to the rejections will be addressed in the order presented by Applicant in the Remarks.

1) Applicant argues that the finality of the previous Office action should be withdrawn on the basis that claims 33 and 34 were not rejected despite the claims being product claims directed towards a biochip, which is commensurate with the scope of the elected claims. This argument is not persuasive because claims 33 and 34 are still commensurate in scope with the withdrawn method claims. Specifically, claims 33 and 34 merely recite a biochip formed by the withdrawn method claims for making a biochip. It should be noted that the withdrawn method claims inherently produce biochips. That said, despite claims 33 and 34 being product claims, they merely recite the end product of the process recited in the withdrawn method claims. They are not patentably distinct from the withdrawn method claims such that they should be grouped with the elected product claims. Therefore, they were properly withdrawn from further consideration by the Examiner.

2) Applicant argues that the finality of the previous Office action should be withdrawn because the amendment filed on December 1, 2008 did not necessitate the application of the Wang et al. reference in the final rejection. This argument is not persuasive. It should be noted that the amendment necessitated the withdrawal of the rejection based on the Agrawal et al. reference, at which point three new references were applied against the amended claim (one of them being Wang et al.). Regarding amendment necessitating new grounds of rejection, the propriety of the finality of an Office action is determined based on the amendment with respect to the prior art being withdrawn as a result of the amendment, not the amendment with respect to the new references that are applied against the amended claims. In this instance, Applicant amended the claims to include a feature (the upper substrate) not disclosed by Agrawal et al. Thus, the amendment necessitated the withdrawal of the rejection based on the Agrawal et al. reference and necessitated application of new references against the amended claims. Thus, the finality of the Office action was proper.

3) Applicant argues that the rejected claims are patentable over the cited prior art because the disclosure of the Wang et al. reference is not analogous art. Specifically, Applicant argues that the disclosure of Wang et al. is directed towards an array of nanotubes whereas the disclosure of Austin et al. is directed towards an array of micro pillars. Thus, Applicant argues that there is no motivation for combining the teachings of the two references. This argument is not persuasive. It should be noted that the disclosure of both references are directed toward molecular sieves. Although the device disclosed by Austin et al. uses an array of micro pillars to form the sieve and the device disclosed by Wang et al. uses an array of nanotubes to form the sieve, the individual micro pillars and nanotubes disclosed by the references have similar dimensions (i.e. length in the range of microns). The disclosure of Wang et al. was relied upon solely for its disclosure of the optimal aspect ratio of the individual structures for making a molecular sieve. Because of the similar dimensions of the sieve arrays disclosed by the two references, the Examiner maintains the position that the aspect ratio disclosed by Wang et al. is pertinent to the disclosure of Austin et al. despite the fact that the references disclose the use of different materials for creating sieve arrays. For the foregoing reason, Applicant's argument that the claims are patentable over the cited references is not persuasive.